



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,134	11/17/2000	Robert Fine	485-001	8656
7590 12/21/2005			EXAMINER	
Anthony R Barkume Esq 20 Gateway Lane Manorville,, NY 11949			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 12/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,134

Applicant(s)

FINE ET AL.

Examiner

Khanh H. Le

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/27/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

1. This Office Action is in response to the amendment filed December 27, 2004. Claims 1-46 are pending. Claims 1 and 24 are independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1, 24 and all their dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The limitation “for ...integrating both print and online management functions” in the preamble is confusing because the body of the claim does not refer to any integrating steps or means. It is not clear what is being integrated. Managing both print and online publishing functions using the same system would also mean integrating both, since “integrating” also means “joining or uniting” under the same system. This will be the interpretation for prior art application. As the phrase seems redundant, appropriate correction is required.

Response to Arguments

4. The phrase “for managing and integrating both print and online management functions” which only recites the use or purpose of the claimed invention in the preamble is not considered to limit the scope of the claim and thus is given no patentable weight.

First, when the body of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness, the preamble does not usually limit the claim. *Kropa v. Robie*, 88 USPQ at 480-481; *Rowe*, 42 USPQ2d at 1553; and *IMS Technology Inc. v. Haas Automation Inc.*, 54 USPQ2d 1129, 1137 (Fed. Cir. 2000). Here, the above phrase does not give meaning to the limitations recited in the body of the claim, since the body of the claim is entirely self-contained and sets out the complete invention, does not refer back to that phrase, i.e. the phrase does not provide antecedent basis for terms in the body of the claim, and the phrase is not essential to understand limitations or terms in the body of the claim. The phrase does not change the structure of the system, as claimed, or steps of the method claims, thus the above phrase is non-limiting.

Second, a phrase that only recites the use or purpose of the claimed invention, generally does not limit the claim. That the statement of use or purpose is moreover, in the preamble, as in the instant case, further reinforces it being non limiting. See *Catalina*, 62 USPQ2d at 1785.

Therefore the previous rejections are maintained.

5. In the alternative, if the above phrase in the preamble is found to be limiting, the following rejections are made:

A. Claims 1,4, 11, 24, 27 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. US 6026368.

Brown discloses all the limitations of the body of the claims as discussed below and in the previous Office Action.

Further, as now amended, it is interpreted that ,the invention is drawn to a network system for managing both print and online publications. The system includes at least one network server storing a plurality of data in data tables including advertisements, advertisers,

articles, designed to manipulate those data, in order to manage the publication process and produce reports thereof. Users (content providers, advertisers) connect their computer terminals to the server and enter criteria so that the system would generate reports in accordance with those criteria. The users can also modify records in any of the database tables.

Brown teaches all the elements of the system as discussed above for online publications but Brown does not teach the specific data used in managing print. However, the specific meaning/interpretation of the data pertaining to print loaded onto the server and manipulated by the different modules to allow the management of print, does not patentably distinguish the claimed system.

Further, the recited statement of intended use, for managing print, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of data in the system taught by Brown because the subjective interpretation of the print data does not patentably distinguish the claimed invention, a computer system.

Further, it would have been obvious to one of ordinary skill in the art to add to Brown's online publications management functions, print data, as discussed above, and thereby manage print management functions, if one's customers include print publishers/advertisers as well. It would have been obvious to use the Brown publications management systems for print publications, in that case, to accommodate the print customers, because the same databases, servers and processing means used in Brown can readily be used to manipulate print publications data, as discussed above, to generate the corresponding reports.

Further, some modifications of a prior art system have been considered to be within the level of the ordinary skill in the art follow. To duplicate parts for multiple effects has been so held. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F.2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960). Here the claimed invention effectively duplicate the databases management functions and reporting functions from online to print publications using the exact same means thus would be obvious as held above.

Art Unit: 3622

Further, such a modified Brown system would manage both print and online publications and thus effectively “integrate (i.e. join, or unite) both print and online management functions”, as claimed.

(Note also that the recited statement of intended use, “for managing and integrating both print and online management functions” does not patentably distinguish the claimed system.)

The rest of the claims are rejected as follows, following the same analysis as set forth below and in the previous Office Action.

B. Claims 2, 25, 13, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Herr-Hoyman et al., US 5727156, hereinafter Herr-Hoyman.

C. Claims 3, 5-7, 8, 10, 15, 17-23, 26, 28-30, 31, 33, 38, 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Merriman, US 5948061.

D. Claims 9,12, 16, 32 , 35, 39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Merriman, and further in view of Reilly et al., US 5740549.

E. Claims 14, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Reilly et al., US 5740549 A.

F. Claims 14, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Reilly et al., US 5740549 A.

The following is essentially a repeat of the previous Office Action.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1,4,24, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. US 6026368.

As to claims 1, 24, Brown discloses

A publishing management system comprising

A) at least one advertisement computer means for storing a plurality of advertisement files (this is implied, see at least col. 11 table 4);

B) at least one article computer means for storing an article file; and

C) a publishing management server computer comprising:

(i) user interface means for receiving data from and sending data to a user;

(ii) database means for storing a plurality of database tables, said database tables comprising:

a) an advertisement table (see at least col. 11 table 4)

comprising a plurality of advertisement records, each advertisement record comprising information regarding an advertisement file stored on an advertisement computer means;

b) an advertiser table (see at least Figs. 4 item 42 and associated text col. 4 lines 35-36);

comprising a plurality of advertiser records, each advertiser record comprising information regarding an advertiser associated with at least one advertisement file stored on an advertisement computer means;

c) an article table (see at least Fig. 4, item 44 and associated text; col. 4 lines 9-10);

comprising a plurality of article records, each article record comprising information regarding an article file stored on an article computer means;

and

(iii) processing means adapted to:

a) generate a plurality of reports as a function of one or more of the database tables (see at least Fig.8 and associated text; col. lines 1-19);

b) allow a user to input, via the user interface means, criteria for generating the reports (see at least col. 26 lines 20-27);

c) provide the reports to a user via the user interface means (see at least col. lines 1-19)
; and

d) allow a user to enter or modify, via the user interface means, records in any of the database tables (see at least col. 8 lines 30-41)

As to claims 4, 27, Brown discloses a subscriber table with plural subscribers of the system records (see at least col. 10 lines 3)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. US 6026368.**

As to claims 11,34 Brown discloses article records comprising article description fields, article resource locator, Brown does not disclose article active/inactive field, or table of contents field but Official Notice is taken that these types of data are common to describe an article thus one skilled in the art at the time of the invention would have known to add these features to Brown's system of identifying the article to further categorize it for enhanced data retrieval and manipulation.

10. **Claims 2, 25, 13, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Herr-Hoyman et al., US 5727156, hereinafter Herr-Hoyman**

As to claims 2, 25, 13, 36, Brown does not disclose an author table nor article records comprising author fields, but Herr-Hoyman discloses authoring a web page and storing it w/ author ID, pass word to modify.

One skilled in the art at the time of the invention would have known to add Herr-Hoyman's above teaching to Brown's system to identify the authors to articles/web pages. Official Notice is taken that it is well-known to link any type of data as desired using standard database linking tools. Thus it would have been obvious to one skilled in the art at the time the invention was made to create author tables and records and associate them with the articles to allow quick searches.

11. Claims 3, 5-7, 8, 10, 15, 17-23, 26, 28-30, 31, 33, 38, 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Merriman, US 5948061.

As to claims 3, 26, 15, 38 Brown does not disclose a partner table, nor article records comprising associated partner sites fields, however it is interpreted that a publication belonging to a party makes that party a partner of the system. Also Merriman discloses matching partner pages to ads (see at least col. 3 lines 57-59). Merriman further teaches that many databases can be compiled for system analysis (see at least col. 5 lines 5-7). Thus it would have been obvious to one skilled in the art at the time the invention was made to tabulate partner records into tables as well as associate partners as fields to article records to allow linking system partners to the articles.

As to claims 5-7, 28-30, Brown does not specifically disclose but Merriman discloses generating a composite article which is in HTML code, comprising an article file and one ad reference which is a URL associated with the composite article (see at least col.3 lines 26-62; lines 35-37). It would have been obvious to one skilled in the art at the time the invention was made to add such Merriman teaching to Brown to allow associating the content articles and ads (see Brown, abstract) in an Internet environment.

Art Unit: 3622

As to claims 8, 10, 31, 33 Brown discloses ads records comprising the ad files, ads description fields (see at least col.11 table 4), start/end fields (see at least col. 14 lines 17-18 ; (see at least col. lines). 13 ,Table 7). Brown does not discloses but Merriman discloses ad resource locator (see at least col.3 lines 26-62; lines 35-37), partner site permission (see at least col. 3 lines 57-59) or article fields (see at least col.3 lines 47-49) associated with the ad.

As to claims 17, 40, (dependent on claims 1, 24, respectively), Brown does not specifically disclose but Merriman discloses an advertiser lead report comprising a list of advertiser lead records (see at least Figs 3A-3C. and associated text; (see at least col. lines). 8 lines 32-47), which comprises a subscriber ID, a list of articles previously accessed by that subscriber within a time period, a list of ads associated with those articles within a defined period of time. In view of Merriman's teaching that any type of report can be put compiled (see at least col.8 lines 32-35), it would have been obvious to one skilled in the art at the time the invention was made to derive all the above data from the teachings of Merriman and derive any reports as desired as taught by Merriman and add them to the Brown system for any data manipulation.

As to claims 18, 41 (dependent on claims 1, 24 respectively), Brown does not specifically disclose, but Merriman discloses an article usage report comprising a list of articles and the number of subscribers that access each article in a given time period (see at least col.4 lines 56-64; col.8 lines 40-41; Fig. 3B and associated text)

One skilled in the art at the time of the invention would have known to these teachings of Merriman to Brown as a tool for billing.

As to claims 19, 42 (dependent on claims 1, 24 respectively), Brown does not specifically disclose but Merriman discloses an article activity report (see at least col. 8 lines 34-45).It would have been obvious to one skilled in the art at the time the invention was made to add this teaching to Brown to analyze the matching appropriateness between article and ads.

Art Unit: 3622

As to claims 20-23, 43-46 (dependent on claims 1, 24 respectively), , Brown does not specifically disclose but Merriman discloses distributed computing. (see at least col. 9 lines 5-16). It would have been obvious to one skilled in the art at the time the invention was made to add to the Brown's system distributing storage and processing tasks among different computers as taught by Merriman as the system configuration requires.

12. Claims 9,12, 16, 32 , 35, 39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Merriman, and further in view of Reilly et al., US 5740549.

As to claims 9, 32 , (dependent on claims 8, 31, respectively), 12, 35, 16, 39, (dependent on claims 1, 24, respectively), neither Brown nor Merriman disclose the article field or record indicate an ad display position within the article . However Reilly discloses such at ((see at least Figs. 6,7b, 8, 9 and associated text; ad linked to story linked to script that defines a position; col. 10 l. 19-25,l. 56-62). It would have been obvious to one skilled in the art at the time the invention was made to add the above Reilly teaching to Brown/Merriman system to allow displaying the ad in the article exactly as specified as taught by Reilly.

As to claims 16, 39 (dependent on claims 1, 24, respectively),

Brown discloses reports generated comprise ads contracts reports, comprising contract records of a system advertiser (see at least (see at least col. lines). 4 l. 35-51; col.26 lines 1-26 :” each customer”); ad records comprising description of the advertiser (see at least col. 7 table 1: “data source originator”), description of the advertisement associated with the advertiser (see at least col.7 Table 1”data source name”), start/end date of the ad (see at least col.7 table 1: valid start/end dates). For the rest of claim 16, 39 see above claim 9, etc...

13. Claims 14, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Reilly et al., US 5740549 A.

As to claims 14, 37 (dependent on claims 1, 24 respectively), Brown does not disclose the article records comprise an article topic field however Reilly discloses such (see at least Figs. 8 and associated text: news weather).

One skilled in the art at the time of the invention would have known to add such feature to the Brown's system to further categorize the articles for enhanced data retrieval and manipulation.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular

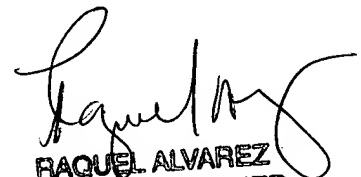
Art Unit: 3622

communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 12, 2005


KHL


RAQUEL ALVAREZ
PRIMARY EXAMINER